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10/553,206	12/13/2005	Kjell Sandaker	5060-0102PUS1	1263

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EXAMINER	
CANTELMO, GREGG	
ART UNIT	**PAPER NUMBER**
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Mailed :
MAR 19 2010

In re Application of
Sandaker
Serial No. 10/553,206
Filed: December 13, 2005
For: BUFFER/CONVERTER/DUMPING SYSTEM
BETWEEN FUEL CELLS AND PROCESS

DECISION ON
PETITION

This is a decision on the PETITION FILED UNDER 37 CFR 1.144 to review the restriction requirement set forth on August 10, 2009 and made final by the Examiner on July 2, 2009. Applicant made a contingent petition request in Applicants response to the Examiner's Office Action on November 2, 2009. It is noted that the application is a national stage application and lack of unity of invention rules control.

When making a lack of unity of invention requirement, the examiner must (1) list the different groups of claims and (2) explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group.

The Examiner determined that Group I (claims 1-6) were drawn to a fuel cell system and that Group II, claim 7 was drawn to a method of use of a fuel cell system. The inventions listed as Group I and II do not relate to a single general inventive concept under PCT rule 13.1 because the apparatus of Group I is not limited by the method steps of Group II and this the special technical method steps of Group II are not requisite of the Apparatus of Group I.

The Examine further made a species requirement for Group I. The species requirements were (1) election of the device being a stationary or mobile device; (2) election of a particular buffer of claims; (3) election of a particular system component combination; (4) election of a particular dumping device; (5) election of a particular converter and (6) election of particular subsystem/subsystems.

Applicant noted that not all of Applicants' grounds of traversal of the restriction/election of species requirement have not been made and that the Examiner's Office Action fails to address Applicant's arguments which traverse the election of species requirement. Applicant further asserts that this is a tacit withdrawal of the election of species requirement. Applicants further assert that the Office Action also improperly fails to

address Applicant's arguments that there is no undue administrative burden on the Examiner to examine all pending claims. Applicant also asserts that the Examiner has no authority to ignore the explicit requirement of 37 CFR 1.475 to examine on their merits claims directed to a process and an apparatus specially designed for carrying out the process.

§ 1.475 Unity of invention before the International Searching Authority, the International Preliminary Examining Authority and during the national stage.

(a) An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

(1) A product and a process specially adapted for the manufacture of said product; or

(2) A product and process of use of said product; or

(3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or

(4) A process and an apparatus or means specifically designed for carrying out the said process; or

(5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

(c) If an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b) of this section, unity of invention might not be present.

(d) If multiple products, processes of manufacture or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other categories related thereto will be considered as the main invention in the claims, see PCT Article 17(3)(a) and § 1.476(c).

(e) The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

When the Office considers international applications under 35 U.S.C. 371, PCT Rule 13.1 and 13.2 will be followed when considering unity of invention of claims of different categories. PCT Rule 13.2 no longer specifies the combinations of categories of invention which are considered to have unity of invention. The categories of invention in former PCT Rule 13.2 have been replaced with a statement describing the method for determining whether the requirement of unity of invention is satisfied.

Unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more special technical features. The term "special technical

features" is defined as meaning those technical features that define a contribution which each of the inventions considered as a whole, makes over the prior art. The determination is made based on the contents of the claims as interpreted in light of the description and drawings. Whether or not any particular technical feature makes a "contribution" over the prior art, and therefore constitutes a "special technical feature," should be considered with respect to novelty and inventive step.

The Examiner sets forth a position that there was a clear absence of a common special technical feature between the claimed apparatus and process. The apparatus of Group I is not limited by the method steps of Group II. Further, the record does not indicate a withdrawal of the election of species by the Examiner. The Examiner in setting forth the lack of unity did not have to show undue administrative burden.

DECISION

The petition is **Denied**.

/JACQUELINE STONE/

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